

Serial No. 10/780,197

REMARKS

Claims 6 and 11 have been placed in independent form including all of the limitations of the base and intervening claims.

The Examiner recognizes that Cast does not disclose the use of a groove to hold an O-ring but asserts the structure shown is effectively an integral O-ring, not needing a groove to set in, and as such is equivalent in the art. This is an improper rejection for several reasons. First assuming it is equivalent (which the applicant contests), this is not a proper basis for rejection. Specifically, as set forth in MPEP§2144.06:

In re Scott, 323 F.2d 1016, 139 USPQ 297 (CCPA 1963) ...The court reversed, holding that components which are functionally or mechanically equivalent are not necessarily obvious in view of one another..."

Examining the Scott decision, the CCPA held:

We disagree with the supposed logic of the Patent Office position. The Examiner and the board appear to hold that the mere existence of "functional and mechanical equivalence" establishes "obviousness". We think this involves a non-sequitur. Expedients which are functionally equivalent to each other are not necessarily obvious in view of one another. The statutory mandate of 35 U.S.C. 103 is that the claimed subject matter be unobvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. [Emphasis theirs]

Thus, even assuming that the structure of Cast is equivalent, for the sake of argument, does not support that the recitations of the claims (which apparently the Examiner concedes do not exist in Cast) are obvious.

Furthermore, it is respectfully submitted that the structure of Cast is not equivalent to that of the present invention as the structure of the present invention is easier to manufacture with less tolerance, allows easily replaceable wear components, and the like. Thus, the present invention is not equivalent.

Thus, it is respectfully submitted that the rejections of claims 6 and 11 have been overcome for these separate and independent reasons. Favorable reconsideration is respectfully requested.

It should be appreciated that the advantage of two rings is that the first ring can be utilized to develop the friction whereas the second ring can be utilized to develop vacuum. Thus, the use of two rings enhances functionalities not suggested in the prior art and is not merely a duplication of parts. Thus, it is respectfully submitted that the rejections of claims 6 and 11 have

Serial No. 10/780,197

been overcome for these separate and independent reasons. Favorable reconsideration is respectfully requested.

The Examiner has cited the United States patents listed in NOTICE OF REFERENCES CITED as A, B and E-J in the Office communication of September 24, 2004 and indicated consideration of the United States patents cited by applicant. By the lack of application of these references and others like them within the classes or subclasses searched, the Examiner apparently recognizes the clear patentability of the present invention over any of these references.

Therefore, since the claims of the present application have been shown to include limitations directed to the features of applicants' nail stapler which are neither shown, described, taught, nor alluded to in any of the references cited by the Examiner and by the applicants, whether those references are taken singly or in any combination, the Examiner is requested to allow claims 6 and 11, as amended, of the present application and to pass this application to issue.

Respectfully submitted,

Chu-Kuo Wang & Mu-Yu Chen



Alan D. Kamrath, Reg. No. 28,227
NIKOLAI & MERSEREAU, P.A.
Attorneys for Applicant(s)
900 Second Avenue South
Suite 820 International Centre
Minneapolis, MN 55402
Tel: (612) 392-7306
Fax: (612) 349-6556

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